

### **REMARKS**

Claims 1, 3, 5-23, 25-36, 38-46, 48-54, 56-71, 74-89, and 91-96 are now pending and stand rejected. Applicant is submitting a Request for Continued Consideration ("RCE") with this Preliminary Amendment. By this Preliminary Amendment, Applicant has amended claims 1, 26, 67, 81 and 86 to further emphasize the distinctions from the prior art. By this preliminary amendment, Applicant also demonstrates reasons why the claims pending here are distinct from the asserted art. In particular, Applicant has amended claims and has canceled claims. In view of the above amendments to the claims and the legal reasoning show below to demonstrate why the 35 U.S.C. § 103 rejections are improper, Applicant respectfully requests the Examiner to reconsider the outstanding rejections and to withdraw them.

#### ***Discussion of 103 Rejections***

Claims 1, 3, 5-19, 23, 25-27, 29-30, 32-33, 35, 38-39, 41-44, 46, 48-51, 53, 56-59, 67-69, 71, 74-75, 78-80, 86, 88-89, 91-92, and 93-94 are rejected under 35 U.S.C. Section 103(a) as unpatentable over Janakiraman et al., U.S. Patent Application Publication No. 2002/0124020, in view of Nelson et al., U.S. Patent No. 6,498,897 (hereafter Nelson) and further in view of U.S. Patent No. 6,877,037 to Adachi. In paragraph 22, the Examiner rejected claims 20-22, 34, 45, 52, 60, 76-77 and 95-96 as unpatentable over Janakirama, Nelson, and Adachi as applied to claims 1, 23, 35, 46, 53, 67, and 86, above and further in view of U.S. Patent No. 6,473,609 to Schwartz. In paragraph 31 of the office action, the Examiner rejected claims 61-62, 64-65 and 81-82 as unpatentable over Janakiraman in view of Castell (U.S. Patent Application Publication No. 2002/0132607). In paragraph 36 of the office action, claims 63 and 83-84 are rejected under 35 U.S.C Section 103(a) as unpatentable over both Janakiraman and Castell as applied to claims 61 and 81, and further in view of Adachi. In paragraph 38 of the office action, claims 66 and 85 are rejected under 35 U.S.C. Section 103(a) as unpatentable over both Janakiraman and Castell as applied to claims 61 and 81 above, and further in view of Schwartz et al.

Applicant requests reconsideration of the claims and rejections here in view of the recent standard for obviousness. The Supreme Court set the standard for evaluating obviousness in its recent decision (*KSR International Co. v. Teleflex Inc. et al.* (550 U.S. 127 S. Ct. 1727 (2007))) to be "expansive and flexible" and "functional." But, the standard is not controlling. Instead the

various noted factors only “can” or “might” be indicative of obviousness based on the facts. The Supreme Court in *KSR* enunciated the following principles:

“[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, Section 103 likely bars it patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill....[A] court must ask whether **the improvement is more than the predictable use of prior art elements according to their established functions.**

The Supreme Court in *KSR* also stated that:

a patent composed of several elements is not proved obvious merely by demonstrating that **each of its elements was independently known in the prior art.**

The Supreme Court in *KSR* has also stated that:

[o]ften, it will be necessary for a court **to look to interrelated teachings of multiple patents;** the effects of demands known to the design community or present in the market place.

Further, the Supreme Court stated in *KSR* that:

The Court [in *United States v. Adams*, 383 U.S. 39, 51-52 (1966)] relied upon the corollary principle **that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.**

With respect to claims 1, 23, 35, 46, 53, 67 and 86, the Examiner simply states that Janakiraman teaches all the claimed limitations and is silent on “sending a list of supported formats to a proxy server.” The Examiner suggests curing this deficiency by introducing Nelson, for its teaching in a wireless communication method, of “sending a list of supported formats [col.4, lns.23-26 i.e. MPEG-1, MP EG-2, MPEG-4, H.263, Realvideo, and other packetized forms of digital media] to a proxy server [item 44 of fig.51 [figs.2-41].” Moreover, the Examiner indicates the following:

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Janakiraman in view of Nelson by sending a list of supported formats to a proxy server because this feature enables to select the appropriate format and applications for playback based upon the specific characteristics [Nelson, col.2, lns.46-52]. It is for this reason that one of ordinary skill in the art at the time of the invention would have been motivated to modify Janakiraman in view of Nelson in order to properly initialize the decoder for the media format [Nelson, col.1, lns.24-25].

Claims 1, 67, and 86 recite the limitation of “automatically updating the list of supported formats, which is not met by either Janakiraman nor Nelson. Both references are silent at least on this limitation, however, the Examiner asserts yet another reference, Adachi, indicating that it discloses automatically updating the list of supported formats to reflect the changes in applications included in the electronic device [see abstract and fig.5]. Therefore, the Examiner believes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify both Janakiraman and Nelson, further in view of Adachi by automatically updating the list of supported formats because this feature allows efficient updating of a number of data modules by sending only one location registration request to the network [Adachi, col.1.8, lns.52-57]. The Examiner asserts that it is for this reason that one of ordinary skill in the art at the time of the invention would have been motivated to modify both Janakiraman and Nelson in view of Adachi in order to receive the copy of the most recent data and the version number from the server system and updates that are installed [Adachi, col.1, lns.65-67]. Respectfully, any updating of “data modules” that occurs is triggered by some action taken by the user, which cannot be characterized as “automatic.”

Applicant respectfully submits that **the improvement is more than the predictable use of prior art elements according to their established functions.**

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***Conclusion***

Applicant respectfully requests the Examiner to reconsider the claims here either based on the amendments, arguments or the legal reasoning urged here. In the event there are outstanding issues, the Examiner is requested to call the undersigned to resolve them.

Respectfully submitted,

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